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	First Named Inventor	Kenneth F. Carpenter, Jr.
	Art Unit	2623
	Examiner Name	Scott E. Beliveau
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PATENTS

Attorney Docket No. UV-180

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellants : Kenneth F. Carpenter, Jr. et al.
Application No. : 09/773,883 Confirmation No. : 7944
Filed : January 31, 2001
For : INTERACTIVE TELEVISION APPLICATION
WITH NAVIGABLE CELLS AND REGIONS
Art Unit : 2623
Examiner : Scott E. Beliveau

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March 14, 2008

REPLY BRIEF

Sir:

Pursuant to 37 C.F.R. § 41.41(a), appellants are filing this Reply Brief in reply to the Examiner's Answer dated January 25, 2008 (hereinafter "the Examiner's Answer"), and in support of their appeal from the rejection of claims 66-91 in the Office Action dated October 18, 2006. Appellants previously filed an Appeal Brief on August 17, 2007 and an Amended Appeal Brief on October 5, 2007 (hereinafter "Appeal Brief") in connection with this case.

REMARKS

I. Introduction

Appellants maintain the position that claims 66-91 of the present application are patentable over the combination of Eldering et al. U.S. Patent App. Pub. No. 2002/0026638 A1 (hereinafter "Eldering"), the "IBM Technical Disclosure Bulletin" (hereinafter "IBM Bulletin"), Matthews III U.S. Patent No. 5,815,145 (hereinafter "Matthews '145"), and Matthews III U.S. Patent No. 6,025,837 (hereinafter "Matthews '837"). Appellants submit that the Examiner's Answer is insufficient as a matter of law to uphold the obviousness rejections for at least the reasons set forth in appellants' Appeal Brief. Appellants have filed this Reply Brief to address comments in the January 25, 2008 Examiner's Answer and to further demonstrate the patentability of pending claims 66-91.

II. Summary of the Examiner's Answer

The Examiner's Answer maintains the § 103(a) rejection of claims 66-91 from the October 18, 2006 Office Action and restates the same grounds of rejection from that Office Action.

The Examiner's Answer also provides a "Response to Arguments" section that attempts to rebut some of the arguments presented in appellants' Appeal Brief as well as provide a new interpretation of appellants' claim language.

III. Summary of the Appellants' Reply

Appellants' Appeal Brief fully addresses the grounds of rejection stated in the October 18, 2006 Office Action.

This Reply Brief addresses the Examiner's comments on appellants' arguments contained in the Appeal Brief. Appellants submit that the Board should find the rejections

of claims 66-91 to be in error and should reverse the Examiner.

IV. Appellants' Reply to the Examiner's Answer

Appellants submit that the Examiner's Answer is insufficient to uphold the 35 U.S.C. § 103(a) rejections of claims 66-91 at least because the prior art references cited in the rejections, even when combined, still fail to show or reasonably suggest all of the claimed features recited in independent claims 66 and 76. Moreover, even if the combination of references did show or reasonably suggest all of appellants' claimed features, there would be no reason why one skilled in the art would combine the references in the manner suggested by the Examiner.

A. The Examiner's New Interpretation of Appellants' Claims is Unreasonable

In the Examiner's Answer, the Examiner seems to advance a new interpretation of appellants' claim language. According to the Examiner, "[t]he claim language does not require that navigation is made using the highlighting border per se as opposed to allowing a user to navigate a region highlight to the region." See Examiner's Answer, page 16. As a result, the Examiner contends that "a user could merely select . . . a given region whereby the region highlight moves or is navigated from a previous region to a new one." *Id.* Appellants respectfully disagree and submit that this new interpretation of appellants' claim language is unreasonable.

Appellants' claim language is quite clear about navigating using a region highlight. For example, the independent claims recite "allowing a user to navigate a region highlight to the region, wherein no cell highlight appears on the display while the user is navigating the region highlight." From this language, it is clear that

appellants' claimed invention involves a two-step navigation approach. First a user navigates a region highlight to the desired region, and then, in response to a user selection of the region surrounded by the region highlight, the user is allowed to navigate a cell highlight to each cell within that region. The Examiner's assertion that the claims do not recite navigation using a region highlight is therefore without basis.

Moreover, appellants' specification includes numerous examples of navigating a display by region using a region highlight. See, e.g., FIGS. 7A-7E, pages 24, l. 7 - page 26, l. 25. As the Examiner is undoubtedly aware, claims must be given their broadest reasonable interpretation "in light of the specification." *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 U.S.P.Q.2d 1321 (Fed. Cir. 2005) (quoting *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 U.S.P.Q.2d 1827 (Fed. Cir. 2004)). Construed with regard to the specification, there can be no doubt that appellants' claimed invention includes the ability to navigate a region highlight to a desired region, and then, in response to a user selection of the region surrounded by the region highlight, the ability to navigate a cell highlight to each cell within that region. Any other interpretation is unreasonable and inconsistent with appellants' specification.

B. The Examiner Admits that Appellants' Claims,
As Properly Construed, Are Not Shown or
Suggested By The Combination of References

In the Examiner's Answer, the Examiner admits that navigation by frames "is not explicitly disclosed" by any of the references. See Examiner's Answer, page 15. As a result, if appellants' claims are properly construed as described above, the *prima facie* case of obviousness necessarily fails. None of the references show or suggest navigating a region highlight to a desired region, and then,

in response to a user selection of the region surrounded by the region highlight, navigating a cell highlight to each cell within that region. As argued in appellants' Appeal Brief, the combination of references cited by the Examiner does not show or reasonably suggest all of appellants' claimed features. See Appeal Brief, pages 7-10.

To help make up for deficiencies in the 35 U.S.C. § 103 rejection, the Examiner now cites to keyboard shortcuts, such as "Ctrl+Tab or F6," to support navigation by region highlight. See Examiner's Answer, page 15. According to the Examiner, "it is well understood by those skilled in the art that users can navigate within web-pages to select or focus on different objects including frames." *Id.* Therefore, according to the Examiner, "it is not unreasonable to conclude that one skilled in the art would recognize that a user could in fact navigate between regions." *Id.*

Appellants respectfully disagree. The Examiner has provided no factual evidence or support for his contention that navigation by frames within a webpage was well-known, especially at the time of appellants' invention. The Examiner has also not provided any factual evidence or support for his contention that any keyboard shortcuts allow a user to navigate by grouped region or that these shortcuts were even available at the time of appellants' invention. Appellants note that traditional webpage technology has not (and does not generally now) allow for navigation using a region highlight, as required by appellants' independent claims. Although the IBM Bulletin briefly mentions providing a highlight to indicate which frame has input focus, this teaching, even when combined with the other references cited by the Examiner, is wholly inadequate to show or suggest navigation using a frame or regions highlight.

As stated in appellants' Appeal Brief, appellants' claimed invention is an improvement over traditional cell-

based navigation techniques that require a user to navigate a display screen on a cell-by-cell or element-by-element basis. By grouping cells into regions and providing a region highlight, appellants' claimed invention facilitates more efficient navigation between and within grouped cells on a display screen. None of the references, alone or in combination, show or reasonably suggest this functionality. For this reason alone, the 35 U.S.C. § 103(a) rejection should be overturned.

C. There is No Reason Why One
 Skilled in the Art Would Make
 The Combination Cited By the Examiner

The Examiner's Answer maintains that it would have been obvious to incorporate the IBM Bulletin's highlight border into Eldering's EPG. See Examiner's Answer, pages 17-18. The Examiner maintains this contention even though he seems to admit that the prior art shows only a frame highlight used for input focus and not a frame highlight used for navigation, as recited by appellants' independent claims. See Examiner's Answer, pages 17. To make up for this deficiency, the Examiner cites to case law supposedly standing for the proposition that it is not necessary that the prior art suggest "the same advantage or result discovered by applicant." See Examiner's Answer, page 17.

Regardless of whether the case law actually stands for the proposition asserted by the Examiner, appellants submit that one skilled in the art would have no reason to combine the references in the manner proffered by the Examiner. It would be especially non-obvious to combine the references in this case because, as the Examiner even seems to admit, the references do not explicitly or implicitly show navigation using a frame highlight. Initially, one skilled in the art would have to modify the IBM Bulletin's region highlight to support navigation between regions, and then one skilled in the art would have to modify Eldering to

incorporate the navigable region highlight into Eldering's EPG. As stated in appellants' Appeal Brief, the motivation for one skilled in the art to make these two modifications is far too conclusory and speculative to support an obviousness rejection under 35 U.S.C. § 103. See Appeal Brief, pages 10-12.

D. The References Teach Away From Being Combined

The Examiner, in the Examiner's Answer, also attempts to rebut appellants' arguments about the references teaching away from being combined. According to the Examiner, the proposed combination would not be superfluous, but rather would provide an "alternative/supplemental method of traversing items within a given frame." See Examiner's Answer, page 19. As such, the Examiner asserts that "the need for a region highlight is not necessarily eliminated by the modification and the references are not believed to teach away." *Id.*

Appellants respectfully disagree. As stated in appellant's Appeal Brief, Matthews '145 approaches the problem of navigable regions in a completely different way than appellants' claimed invention -- a way that negates the need for any region highlight. Namely, as shown in FIG. 6, a user in Matthews '145 may navigate a cursor within a programming tile strip (i.e., programming guide space 150 of FIG. 6) to cause "screen 98 to shift leftward in the programming guide space" (Matthews '145, col. 10, ll. 11-25). Thus, screen 98 of FIG. 4 only displays one region (e.g., of six tiles) of a larger virtual display at a time - the region selected by the cursor in programming guide space 150. Since only one region is displayed in screen 98 at a time, there would be no reason for one skilled in the art to add a region highlight to Matthews '145 in order to navigate between regions in the display screen.

The Examiner seems to suggest that Matthews '145 could use both methods of navigation (the programming tile

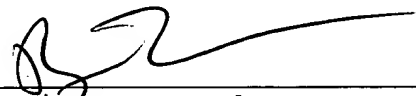
strip plus the region highlight) in the same embodiment. See Examiner's Answer, page 19. While this may be technically feasible, the fact that Matthews '145 already provides a suitable means for navigation weighs against incorporating yet another completely different means for navigation into the system. Because of this teaching away, appellants submit that one skilled in the art would have even less reason to make the modification proposed by the Examiner.

For at least the foregoing reasons, as well as the reasons set forth in appellants' Appeal Brief, appellants submit that the Board should find the § 103(a) rejection of claims 66-91 to be in error and should reverse the Examiner.

V. Conclusion

For at least the reasons set forth above, appellants respectfully submit that claims 66-91 are in condition for allowance. The Examiner's rejections of these claims should be reversed.

Respectfully submitted,



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